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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,947	02/21/2002	Deborah Tucker		6518

7590
JOHN MAIER, III
666 AARON COURT
KINGSTON, NY 12401

05/17/2007

EXAMINER

MICHALSKI, SEAN M

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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05/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/080,947
Filing Date: February 21, 2002
Appellant(s): TUCKER, DEBORAH

MAILED

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Group 3700

John Maier, III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/07/2005 appealing from the Office
action mailed 12/30/2003

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief. Deborah Tucker, the sole inventor, is the real party in interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. Claims 1-4 and 8-17 are pending, and are appealed.

(4) Status of Amendments After Final

The amendment after final rejection filed on 01/22/2004 has not been entered, an advisory action was sent in response to that amendment on 02/11/2004 indicating that the claims would not be entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. It is noted that appellant has titled the section discussing the grounds of rejection "Issue" instead of "Grounds of Rejection to be Reviewed on Appeal".

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix A to the brief is correct. Appellant has chosen to include an Appendix B containing claims which have not been entered, since they had been submitted after final rejection and were properly denied entry. Appendix B of the Appeal Brief should be disregarded during the Appeal, since non-entry of amendments after final rejection is a petitionable grievance, and no petition has been filed.

(8) Evidence Relied Upon

5,432,687 Lane 07/1995
3,645,595 Urquhart et al. 02/1972
2,223,250 Graham 11/1940
2,211,492 Burtis 08/1940
2,099,306 Marshall 11/1937
1,320,537 Diamond 11/1919
337,503 King 03/1886

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 8-17 are rejected under 35 USC 103(a) as being unpatentable over Lane in view of Urquhart.

Lane discloses a memo device which feeds paper from a narrow end to a wide end having

a base panel (43 figure 2)

a writing panel inclined to the base panel (33 figure 1)

a narrow end panel with a slot (119, 42 figures 1 and 2 respectively)

a wide end panel, (29 figure 2)

the writing panel being mounted on the narrow and wide end panels

(figure 1)

a wide end bar (127 figure 1) mounted across the writing panel (figure 1)

slightly above the writing panel (figure 1) and having a cutting edge (the back edge of the bar 127 may be considered a cutting edge, since it is inherently capable of being used as a cutting edge)

a means for mounting a paper roll (journals 121 a and 121 b figure 2 bear against spindle 123 figure 2).

The statement of intended use "may be mounted both vertically and horizontally for making notations on a paper sheet fed from a paper roll which permits starting notations both at the top of the paper sheet and the open end of the roll" has been given patentable weight insofar as the recited memo device must be *capable of* being used vertically and horizontally. This claim interpretation is mandated in MPEP 2106 II C which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use." The memo device of Lane may be used vertically or horizontally, and as seen in figure 1, and allows a user to write on a paper sheet fed

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from a roll which permits starting notations both at the top of the paper sheet and the open end of the roll.

The mounting means is also inherently capable of meeting the functional limitation that the means for mounting is "for rotating and feeding the paper roll in opposite directions". See figure 2, the roll can be picked up and reversed with no modification to the device.

Lane's wide end panel lacks a slot. Lane also lacks a narrow end bar across the narrow end of the writing panel.

Urquhart teaches a memo device which feeds paper from the wide end to the narrow end. Urquhart teaches a memo device with a narrow end bar (11 figure 1) and a wide end bar (11, at the wide end).

In the same field of endeavor it would have been obvious to modify Lane to provide it with the additional functionality of feeding either from the wide end or the narrow end. Urquhart teaches feeding from the wide end, which would suggest, teach or motivate one of ordinary skill in the art to see the value in providing for a wide-end feed memo device. One of ordinary skill in the art would simply duplicate the narrow end feeding slot of Lane to be placed on the wide end as well, since the teaching of Lane is that slots are one way to get paper from a roll out to a memo surface. The paper feed direction would *not* need to be changed or contemplated by the inventor in order to use this modification of a wide end feed narrow end feed construction. However, once the second slot is added to the device, the combination is *inherently capable of feeding in both rotational directions to both slots, so it meets every functional limitation presented*

in the claims regarding rotation direction and feeding through the slots. The motivation to provide dual feed slots would be merely to provide an alternate configuration for feed direction based on a users preference, to accommodate the habits of differing users. The modification, motivated by Urquhart, to provide an additional slot is not beyond the level of ordinary skill in the art, and it is additionally common sense that a multi-use memo device will be more attractive to a consumer than a single use device.

In the same field of endeavor it would have been obvious to modify Lane by adding a narrow end bar to provide for additional support, as shown in Urquhart. Urquhart shows a memo device which supports the paper at the top (wide end) and bottom (narrow end). This clearly better supports the paper. In view of this teaching, one of ordinary skill in the art would have been able to duplicate the wide end bar of Lane, placing it on the narrow end, to provide the well known, obvious common sense feature of better retaining paper. The duplication of a part, where the duplication is shown in the prior art, and has common sense, obvious, and clear benefits is not a patentable feature. It would have been obvious to one skilled in the art at the time of the invention to provide a bar at the narrow end, since it has been held that rearranging the parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70

Regarding claim 2, see figures of Lane.

Regarding claim 3, 10, 15 and 16, Lane discloses a spindle and journal arrangement described above.

Regarding claims 4 and 11, each limitation is described above, or is clearly evident in figure 1 of the Lane patent.

Regarding claims 8, 12 and 13, see Lane figure 1.

Regarding claims 9 and 14, Lane discloses that the panels are at right angles (figure 1).

Regarding claim 17, see Lane figure 2.

(10) Response to Argument

In the appeal brief filed 02/21/2005 appellant states that the "claims under appeal stand or fall together" (page 4 line 11).

The sole argument that appellant has presented is the question of whether the Lane and Urquhart patents, in combination, render the claims unpatentable. This response will address that issue alone.

Examiner notes that no claims have been separately argued, nor have they been given separate subheadings under 37 CFR 41.37 (vii) which states :

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, **the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.** Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

Since no claim is argued separately from claim 1, and claim 1 is the broadest claim, the Examiner will restrict his arguments to claim 1, since all other claims stand or fall by claim 1.

It has been held that the combination of elements known in the prior art to be used in accordance with their known functions *is unpatentable as a matter of law* absent a showing that the combination has results which are *unexpectedly* advantageous over the prior art. Please see *Sakraida v. Ag Pro, Inc.* U.S. Supreme Court No. 75-110 425 US 273, 189 USPQ 449 (1976), Which states "patent[s] for combination that only unites old elements with no change in their respective functions withdraws what is already known into field of its monopoly and diminishes resources available to skillful men" and [a] patent [which] simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations...are not patentable under standards appropriate for a combination patent"; also see *Anderson's Black Rock, Inc. v. Pavement Salvage Co., Inc.* U.S. Supreme Court 396 US 57, 163 USPQ 673 (1969) which states "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented". Similarly here, the combination of a top-down and bottom-up feeding memo device performs no better than having the Lane and Urquhart devices sitting side by side on a table, or taped side by side to the wall.

The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007) affirmed both Sakraida and Anderson's requirement that to be patentable a combination needed to provide some synergistic effect. See Slip op. at 13 lines 3-19. Using known elements for their known functions is *as a matter of law not*

patentable, since it removes resources available to skillful men, contrary to U.S. Const., Art. I §8, cl.8. which provides patent monopolies to promote the progress of useful arts. See Slip op. *KSR* at 24 lines 5-7.

Each of the elements slots, retention bars (narrow end and wide end), housing walls, writing panels and spindle/journal paper feed roller arrangements are known as seen in the cited prior art (above); their combination is unpatentable absent a showing that one of ordinary skill would be unable to effect their combination, or their combination provides unexpectedly good results (more than a duplicated effect).

In response to appellants argument from the appeal brief filed 02/21/2005 page 5, line 4, that "Neither patent cited by examiner even hints" at a device "capable of use either vertically or horizontally", examiner would like to point out that where a limitation is that a device be "capable of" the recited functions *need not be disclosed* it is enough that the devices are inherently capable of so performing. As seen in the rejection presented above, Lane, and the combination of Urquhart and Lane are both *capable of being used wither vertically or horizontally*.

In response to appellants argument, page 5, line 13, that "there is no question that the paper roll would fall on the ground"; examiner disagrees. The loop of paper, and the retention bars 11 (Urquhart) would work to keep the paper roll from falling even if the device were mounted vertically. This is an inherent property of the device. Assuming *arguendo* that Urquhart was placed in a vertical configuration with the narrow end up,

each time a user pulled on the free end of the paper the roll would *roll away from the ledge towards the wall, ensuring that it did not fall out and become inoperable.*

In response to appellants argument from the appeal brief filed 02/21/2005, page 5 line 7, that "lane fails to teach a device where the direction of the feed is reversible"; examiner disagrees. Lane inherently shows that the feed is reversible. The journal and spindle do not preclude winding the paper in a direction opposite that is shown. The capability to wind the paper in either direction is inherently shown by lane, as is clear from figures 1 and 2.

In response to appellants argument from the appeal brief filed 02/21/2005, page 5, lines 7 and 8, that "Lane also fails to provide a narrow end bar". "One cannot show non-obviousness by attacking the references individually where, as here the rejections are based on combinations of references". See *In re Keller*, 208 USPQ 871 (CCPA 1981). This is not a valid argument.

In response to appellants argument from the appeal brief filed 02/21/2005, page 5 , lines 9-12 , that Urquhart does not teach a slot; examiner disagrees. The channel is a slot, and it is at the wide end. "claims in a pending application should be given their broadest reasonable interpretation" consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). Furthermore, the characterization as a slot is not important to the combination, since Lane teaches slots, and the real *teaching* of

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Urquhart is that the paper may be fed from the wide end, as a matter of design choice.

Urquhart shows that it is known to feed from the wide end of a writing memo device.

In response to appellants argument from the appeal brief filed 02/21/2005, page 5, line 19 and 20, that "wide end slot" would have to be created apart from the cited patents, and "the reversible rotation would have to be developed"; examiner disagrees. After following a strict Graham analysis it is clear that the addition of a wide end slot is within the level of ordinary skill *based exclusively on the teachings of the Lane and Urquhart patents, and their evidence of the level of ordinary skill in the art.* The Reversible rotation has been discussed above, and is an inherent property of intended use *not affecting the structure of the claimed invention.*

In response to appellants argument from the appeal brief filed 02/21/2005, page 6, line 1, that the narrow end bar would have to be developed; examiner disagrees. "One cannot show non-obviousness by attacking the references individually where, as here the rejections are based on combinations of references". See *In re Keller*, 208 USPQ 871 (CCPA 1981). This is not a valid argument. Lane in view of Urquhart clearly renders the addition of a narrow end bar obvious, since one is disclosed in Urquhart, and the use of two bars instead of one (as shown in Lane) is clearly advantageous based on common sense. See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641 (Fed. Cir. 2006), which states that "the suggestion test is not a rigid categorical rule. The motivation **need not be found in the references**

sought to be combined, but may be found in any number of sources, **including common knowledge**, the prior art as a whole, or **the nature of the problem itself**. *In re Dembiczak*, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997), 'there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art.' " (emphasis added).

In response to appellants argument from the appeal brief filed 02/21/2005, page 7, lines 12 and 13, that vertical and horizontal use is "achieved by reversing the flow of paper"; examiner disagrees. The reversal of paper is a functional limitation not imparting any structure to the device. The mounting is achieved by *mounting*. The presence of, or lack of, reversibility or two slots does not effect the mounting.

In response to appellants allegation from the appeal brief filed 02/21/2005, page 7, lines 15-18, that neither device can be hung vertically, and used horizontally; examiner disagrees. Both are clearly and unquestioning *capable of being used in the manner so claimed*, and applicant has presented no evidence to the contrary. When a Prima Facie case of obviousness has been made the burden of proof shifts to appellant to prove by clear and convincing evidence that the combination is not technically feasible.

In response to appellants argument from the appeal brief filed 02/21/2005, page 7, line 18, that neither device "hints" at feeding the paper roll in opposite directions; this is not the test for determining obviousness. Neither device needs to teach reversing the roll, since it is common knowledge that paper rolls (such as toilet paper rolls) can be reversed with their functionality not affected. Furthermore the only recitations pertaining to the roll reversal are functional, and the established combination of Urquhart and Lane is *fully, unquestioningly, inherently* capable of having it's paper roll reversed.

In response to appellants statement from the appeal brief filed 02/21/2005, page 7, lines 19-21, that the claims of appendix A are patentable and the claims of appendix B are patentable; examiner disagrees. This constitutes a general allegation of patentability and presents no reasoning or evidence in support thereof. Furthermore the claims in appendix B are not considered

Art not relied upon in the presented rejection, but indicative of the skill in the art, useful in framing the general flexible inquiry of obviousness as set forth in *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 80 USPQ2d 1641 (Fed. Cir. 2006) and affirmed by *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007) (both of which were decided after the final rejection and appeal brief of the current application) are Graham (US 2,223,250), which shows that one of ordinary skill in the art would have known how to place slots in the narrow and wide ends of the memo device, and also inherently possesses the capability of feeding paper in both directions; Burtis (US 2,211,492), which shows one of ordinary skill in the art contemplated vertically hanging memo devices, with an open end and feed from the

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wide end to the narrow end; Marshall (US 2,099,306) shows that one of ordinary skill in the art contemplated dual use (vertical *and* horizontal mounting) solutions to memo devices with paper roll feed, Dimond (US 1,320,537), which shows slots a narrow end bar for cutting paper, and a slot at the wide end; and King (US 337,503) which shows one of ordinary skill in the art would contemplate the reversibility (bi-directional feed) of memo devices, as indicated by the side numbers being oriented in opposite fashion.

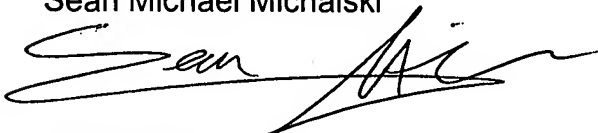
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

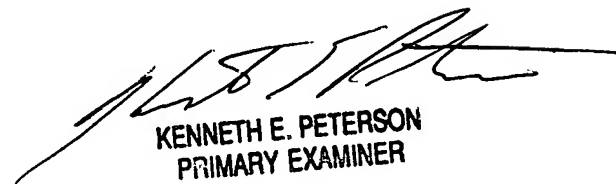
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sean Michael Michalski



Conferees:



KENNETH E. PETERSON
PRIMARY EXAMINER



Supervisory Patent Examiner Joseph Hail, Art Unit 3724



Special Program Examiner (SPRE) Allan Shoap TC 3700